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JULY 26, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ATL Washington, Inc.

Serial No. 75/122,935

Edward A. Uhl and Frederick J. McKinnon for applicant.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law
Office 105 (Thomas G. Howell, Managing Attorney).

Before Simms, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by ATL Washington, Inc.¹
to register the mark TISSUE SPECIFIC for "medical
apparatus, namely, a feature of a medical diagnostic
ultrasound apparatus consisting of computer hardware and

¹ Later in the prosecution, the owner of the application was identified as "Advanced Technology Laboratories, Inc. (formerly ATL Washington, Inc.)." To date, the appropriate change of name documents have not been filed with the Assignment Branch of the Office. See generally 37 C.F.R. §3.11 et. al.

software for enhancing the recording, storing, formatting and analyzing [of] ultrasound images."²

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, is merely descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.³ An oral hearing was not requested.

Applicant contends that the mark is just suggestive "because a considerable degree of imagination is required on behalf of a consumer to determine the nature of Applicant's goods from the mark." Applicant also contends that the terms "tissue" and "specific" each have a variety of meanings, and that marks which use the term "tissue" in a more descriptive manner than in applicant's suggestive mark have issued on the Principal Register.⁴ Insofar as the

² Application Serial No. 75/122,935, filed June 20, 1996, alleging dates of first use of August 1, 1995.

³ Registration also was finally refused on the basis that the specimens were unacceptable. Applicant indicates in its appeal brief, however, that the Examining Attorney, in a telephone conversation with applicant's attorney, withdrew this final refusal. The Examining Attorney does not dispute this contention and, in point of fact, the Examining Attorney's appeal brief does not mention this refusal. The Board therefore assumes that the refusal stands withdrawn, and no consideration has been given to this refusal.

⁴ Applicant's mere reference to two third-party registrations would generally be insufficient to make the registrations of

NEXIS evidence submitted by the Examining Attorney is concerned, applicant points out that none of the articles relates to ultrasound imaging. Applicant has submitted dictionary listings for the words "tissue" and "specific."

The Examining Attorney maintains that the mark merely describes a significant feature of applicant's goods, namely settings that allow for ultrasound imaging of specific tissue. In support of the refusal, the Examining Attorney has submitted excerpts retrieved from the NEXIS database and dictionary listings for the two terms in applicant's mark.⁵

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties

record; copies of the registrations themselves are required for that purpose. In re Classic Beverage Inc., 6 USPQ2d 1383 (TTAB 1988). Despite this deficiency, the Examining Attorney has considered the registrations as if properly of record. Thus, we have considered them in reaching our decision.

⁵ The dictionary evidence was submitted with the appeal brief, but we are able to take judicial notice of these definitions.

or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods and/or services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, contrary to the gist of some of applicant's remarks, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant's product literature ("Reference Manual") shows the following uses of the term "tissue specific":

From this display, you select the scanhead, a clinical option (listed in the left column on the Scanhead display), and a tissue-specific preset (listed in the right column on the Scanhead display).

This assignment can be accomplished automatically by selecting an ATL-derived tissue specific preset or it can be accomplished by the user, through the creation of a customized preset...For example: within the small parts clinical option, the tissue specific presets are thyroid, testicle, breast, and superficial. If you select the small parts clinical option, these tissue specific presets will be displayed on the Scanhead display for

your selection...The more specific you are about your use of the system, the more precise the system can be about providing the tissue specific setups for that use.

The relationship between a clinical option and the use of the correct scanhead for that option is critical to image quality. The system allows you to optimize the system for use with a scanhead for tissue specific imaging.

The excerpts retrieved from the NEXIS database show the following representative uses:

Using a more common method of cooling...and a tissue-specific imaging modality...
The American Journal of Sports Medicine, January 1995

Thus, the present role of imaging is not to make a tissue-specific diagnosis but to assess tumor aggressiveness...
American Family Physician, April 1992

The term "tissue" is defined as "a collection of similar cells and the intercellular substances surrounding them" and "specific" is defined as "set forth explicitly; intended for, applying to, or acting on a given thing."⁶ The commonly understood meanings of the terms "tissue" and "specific," coupled with the NEXIS evidence and applicant's own descriptive uses, convince us that the mark, when

⁶ Applicant's reference to the fact that "tissue" is also defined as "a soft and very absorbent piece of paper" makes little sense relative to the specific goods to which the mark is applied.

applied to applicant's goods, is merely descriptive as contemplated by Section 2(e)(1) of the Act. Applicant's medical apparatus, as shown by the product literature of record, features "tissue-specific" presets for ultrasound imaging purposes. These presets allow the user of applicant's goods to select the setting that is specific to the type of tissue to be imaged (e.g., thyroid, breast or testicle), which, according to the literature, results in benefits such as faster exams and more consistent images. Thus, a significant characteristic of feature of applicant's ultrasound apparatus is that the goods contain settings that allow for tissue-specific imaging. See: In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996)[VISUAL DESIGNER is descriptive of computer programs for controlling the acquisition of data from measurement devices for the purpose of analysis, display, testing and automatic control; the term describes a feature of the goods, namely that they permit programming applications to be visually designed].

The two third-party registrations are of little help in determining the registrability of the mark at issue in this case. As often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. While uniform

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treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's mark is registrable.

Decision: The refusal to register is affirmed.

R. L. Simms

T. J. Quinn

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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